

REMARKS

Applicant has amended claims 10, 13, and 16. Support for the amendments to the claims can be found in the original claims and as-filed application, e.g., paragraph [0228]. No new matter has been introduced.

The Office Action objected to claims 10 and 13 for allegedly containing informalities. Office Action, pages 2-3. Applicant has amended claims 10 and 13 to remove the cited informalities and respectfully requests withdrawal of the objection to the claims.

Applicant respectfully traverses the rejection of claims 10-12 under 35 U.S.C. § 102(b) over U.S. Patent No. 6,667,285 to Kawahara et al. ("Kawahara") for at least the following reasons.

Amended claim 10 recites, among other things, at least one ester additive selected from monoesters of a linear monobasic fatty acid having 12 or more carbon atoms and a monohydric alcohol having 1-24 carbon atoms.

Kawahara does not disclose expressly or inherently the above-mentioned feature of amended claim 10. Kawahara instead discloses a lubricating oil composition comprising a monoester of a branched monobasic fatty acid and a monohydric alcohol. See e.g., Kawahara, abstract; col. 2, line 64- col. 3, line 40.

Since anticipation under § 102 requires that every claim element be disclosed, expressly or inherently in a single reference, amended claim 10 is not anticipated by Kawahara. Claims 11 and 12 depend from claim 10 and incorporate all of the features of amended claim 1. Accordingly, claims 11-12 also are not anticipated by Kawahara.

Applicant respectfully traverses the rejection of claims 13-18 under 35 U.S.C. § 102(b) over U.S. Patent Application Publication No. 2002/0013233 to Corr et al. ("Corr") for at least the following reasons.

Amended claims 13 and 16 each recites, among other things, a full ester of a diol or a polyol having 3-20 hydroxyl groups with a fatty acid having 6-20 carbon atoms as a base oil. Corr does not disclose expressly or inherently the above-mentioned feature of amended claims 13 and 16.

Amended claims 13 and 16 each also excludes compound (A1), Alkylene oxide adduct of a polyhydric alcohol having 3-6 hydroxyl groups, from the group of oxygen-containing compounds, as claimed. Corr does not disclose expressly or inherently any of the remaining compounds (A3), (A4), and (A5), as recited in amended claim 13. Nor does Corr disclose expressly or inherently any of the remaining compounds (A4) and (A7), as recited in amended claim 16.

Since Corr fails to disclose every element of claims 13 and 16, respectively, amended claim 13 and 16 are not anticipated by Corr. Claims 14, 15, 17, and 18 depend from claims 13 and 16, respectively, and incorporate all of the features of the claim which they depend from. Accordingly, claims 14, 15, 17, and 18 also are not anticipated by Corr.

The Office Action maintained the provisional rejection of claims 10-18 on the grounds of nonstatutory obviousness-type double patenting over claims 1-9 of copending Application No. 10/565,739. Office Action pages 5-6. Applicant respectfully traverses this rejection. Claims 1-9 of copending Application No. 10/565,739 do not disclose or suggest either at least one ester additive selected from monoesters of a

linear monobasic fatty acid having 12 or more carbon atoms and a monohydric alcohol having 1-24 carbon atoms, as recited in amended claim 10; the oxygen-containing compound selected from the group consisting of the (A3), (A4), and (A5), as recited in amended claim 13; or the oxygen-containing compound selected from the group consisting of the (A4) and (A7), as recited in amended claim 16. In addition, since no claims are allowable in either of the relevant applications, Applicant respectfully requests that the double patenting rejection be held in abeyance until allowable subject matter is indicated either in the present application or in Application No. 10/565,739. Once allowable subject matter is indicated, and if the Examiner has not withdrawn the obviousness-type double patenting rejection, Applicant at that time will file a Terminal Disclaimer. See M.P.E.P. § 804(I)(B).

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of the claims, withdrawal of the rejections, and a timely notice of allowance.

If there is any fee due in connection with the filing of this response, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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